

## REMARKS

In the Office Action, the Examiner rejected claims 1-22 under 35 U.S.C. §102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Jancek et al. '988 or Bury et al. '209. In connection with the rejection, the Examiner stated that Jancek et al. teach a composition comprising cement, water, bentonite and ashes (e.g., fly ash) thus anticipating the present invention. Further, the Examiner stated that fly ash itself by its very formation is itself in microsphere form. As concerns Bury et al., the Examiner stated that Bury et al. teach a composition comprising cement, fly ash (which are by its nature microspheres), water, and pozzolana thus anticipating the instant invention.

The Jancek et al. patent teaches a self-hardening suspension for foundation engineering purposes. The suspension comprises 40 to 80% water, a powder mass consisting essentially of from 10 to 40% cement, 2 to 18% bentonite, 1 to 15% hydraulic lime, 0 to 15% ashes and 0 to 40% ground slag and filling materials. In addition, the self-hardening suspension can include a plasticizer. It is clear in the disclosure of Jancek et al. that the ashes, and ground slag are filling materials and are optional in the self-hardening suspension. Further, nothing in Jancek et al. states or otherwise indicates that the ashes are fly ash or fly ash microspheres.

The patent to Bury et al. discloses an additive for concrete, mortar, or grout that includes in addition to other components one or more inert fillers. As stated in the Bury et al. patent in Column 9, beginning at Line 26, one of the many fillers that are useful include fly ash. Nothing in the patent to Bury et al. discloses or suggests that the additive could or should include an additive comprising an aqueous suspension of microspheres and a water swellable clay suspending agent as described and claimed in the present application.

A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. Verdegaal Brothers v. Union Oil Company of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the … claim” and all of the claims elements must be “arranged as in the claim”. Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). The patents to Jancek et al. and Bury et al. fail to satisfy the above requirements.

In order to satisfy a prima facie case of obviousness, the prior art must contain some teachings, suggestion or incentive that would have motivated an artisan to modify the reference. See, In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596 (Fed. Cir. 1988). The prior art must teach or suggest all of the limitations of the claims without the slightest recourse to the teachings in the application. See, Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 18 USPQ 2d 1016 (Fed. Cir. 1991). The proper test is whether “the prior art would have suggested to one of ordinary skill in the art that the process [methods or compositions] should be carried out and would have a reasonable likelihood of success.” In re Dow Chemical Co. v. American Cyanamid Co., 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531-32 (Fed. Cir. 1988). In the present case, the patents to Jancek et al. and Bury et al. do not disclose or suggest the cement compositions of the present invention which basically comprise a hydraulic cement, water and an additive comprising an aqueous suspension of microspheres and a water swellable clay suspending agent.

The Examiner rejected claims 1-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable in view of claims 1-21 and claims 1-19 of U.S. Patents Nos. 6,486,961 B2 and 6,660,078 B2, stating that the claims are not patentably distinct

from each other because both teach the same amounts of components and in overlapping amounts, thus rendering Applicants' invention obvious to one of ordinary skill in the art.

In order to overcome this rejection, a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) is submitted herewith. In view of the terminal disclaimer, Applicants request that the Examiner withdraw the obviousness-type double patenting rejection.

The Examiner rejected claims 1-22 under the first paragraph of 35 U.S.C. § 112 stating that the claimed invention is not commensurate or in scope with Applicants' enabling disclosure and under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which Applicants regard as their invention. In connection with these rejections, the Examiner stated that the Applicants should add amounts as is required by their specification into their independent claims such as independent claim 1. Accordingly, independent claim 1 has been amended to include the amounts of the water and of the additive comprising an aqueous suspension of microspheres and a water swellable clay suspending agent.

It is respectfully submitted by the Applicants that claims 1-4 and 7- 22 remaining in this application are now in condition for allowance, and such allowance is respectfully requested. This is intended to be a complete response to the Office Action mailed on April 2, 2004.

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